

I. The Final Rejection Was Premature in that the Examiner Introduced a New Ground of Rejection that Was Neither Necessitated by Applicant's Amendment Nor Based on Information Submitted in an Information Disclosure Statement Filed Pursuant to 37 CFR 1.97(c)

It is well established that “[b]efore a final rejection is in order, a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy a conclusion as possible and at the same time to deal justly by the both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the *references fully applied*. . . . Switching from . . . one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will . . . tend to defeat attaining the goal of reaching a clearly defined issue.” MPEP 706.07 (emphasis supplied).

In this case, after substantial and protracted examination spanning five years,¹ the examiner finally rejected the claims on new grounds, specifically under § 102 as anticipated by

¹ This application was filed on August 15, 2001. A first office action rejecting the claims under § 102 in view of US Patent 6,269,814 to Blaszczykiewicz was mailed on October 29, 2002 to which a response was filed on January 28, 2003. A final rejection issued on April 9, 2003, rejecting the claims under § 103 in view of the Blaszczykiewicz patent, to which an appeal was taken and a brief filed on September 9, 2003. In view of the brief, the final rejection was withdrawn on November 28, 2003, and a further office action issued, this time rejecting the claims under § 102 in view of US Patent 5,411,484 to Shattuck, and under § 103 in view of the Shattuck patent taken with US Patent 3,878,849 to Muller. Applicants filed a response to that office action on February 25, 2004. A final rejection then issued on May 18, 2004, rejecting the claims under § 102 in view of the Shattuck patent taken with a new reference, US Patent 5,154,690 to Shiono. Applicants filed an appeal brief on October 18, 2004. In view of the appeal brief, prosecution was reopened on January 1, 2005, wherein the examiner issued a further office action, rejecting the claims under § 102 in view of the Shattuck patent, further under § 102 in view of US Patent 4,723,325 to Perry, and under § 103 in view of the Shattuck patent taken with the Muller patent. Applicants responded to the office action on May 11, 2005. The examiner issued a final rejection on the claims on August 19, 2005, withdrawing the previous rejections and citing new grounds, US Patent 5,446,953 to LeFeber, to reject the claims under § 102. Applicants filed a Request for Continuing Application on November 7, 2005, including a preliminary amendment. On January 20, 2006, the examiner rejected the claims again under the LeFeber patent. Applicants responded to the office action on April 12, 2006. On July 11, 2006, the examiner issued the present final office action, rejecting the claims on new grounds.

US Patent 5,117,510 to Broussard. The determination of finality was premature in this case, because the applicants were not given an opportunity to address this ground of rejection so that the issues could be clearly defined.

As advised in MPEP 706.07(a), a final rejection on new grounds is not proper unless the new ground is necessitated by applicant's amendment of the claims or is based on information submitted in an information disclosure statement filed pursuant to 37 CFR § 1.97(c).

The applicants made the Broussard patent of record in an information disclosure statement filed on November 15, 2001, almost one year before the first of eight office actions issued in this case. The examiner never applied the Broussard patent to the claims until July 11, 2006.

The examiner's statement that the new grounds of rejection were necessitated by applicants' amendment is not well taken. Applicants' amendment on April 12, 2006 expressly limited claim 1 to a band composed of no more than two layers of fabric anywhere along the length. There is nothing in that amendment which would call into consideration anything in the Broussard patent.

The claims as amended in April 2006 are to substantially the same subject matter as what had been originally filed in August 2001. The Broussard patent should have been applied to the claims during prosecution so that applicants would have had a fair chance to address it. Instead, the Broussard patent was cited against the claims in a paper that closed prosecution. The applicants are therefor denied just treatment in that they are precluded from addressing a reference that they have made of record but which has never been raised as a ground to deny patentability.

It is respectfully requested that the finality status of the July 11, 2006 office action be withdrawn in order to comport with the goals of the patent system and that prosecution be reopened in this case to fully consider the comments in Section II. *infra*.

II. The Broussard Patent Does Not Disclose the Limitations of a Divided Band or a Closed Loop

The examiner rejected the claims under 35 U.S.C. § 102 as anticipated by US Patent 5,117,510 to Broussard. This rejection is traversed.

Claim 1 recites that the band is divided into at least a first closed loop and a second closed loop. The meaning of the term "divided into" is ascertained by resort to the specification. In the specification at page 4, lines 18-20, the band is divided into closed loops by joining two points along the width of the band, such as by stitching or some other non-disengagable fastening technique. Thus, the term "divided into" should be construed as separating parts of the band from each other. Relatedly, the term "closed loop" refers to one of the separate parts of the band formed by dividing the band.

The Broussard patent does not disclose either of these limitations: it does not show a divided band, nor does it show separate parts of a band forming closed loops. Instead, the Broussard patent discloses a band having holes cut into it to hold forward-facing penlights. Accordingly, Broussard does not disclose all the limitations of the claims of the present invention and therefore does not anticipate the claims. Withdrawal of the rejection is therefore respectfully requested.

III. CONCLUSION

Applicants submit that the claims on review present patentable subject matter. In view of the extensive and protracted examination of this application, applicants requests an expeditious allowance.

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